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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,697	04/04/2002	Takashi Mimura	1061-02	9428

35811 7590 12/28/2004

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/070,697	MIMURA ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claim objections are withdrawn in view of the present amendment.

2. All of the art rejections and double patenting are maintained.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-3, and 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyakawa et al (US 5,672,409) in view of Ishii et al (US 5,710,856) substantially as set forth in the 10/04/2004 Office Action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3, 5, 6, and 8-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of

U.S. Patent No. 5,672,409 in view of Ishii et al (US 5,710,856) substantially as set forth in the 10/04/2004 Office Action.

Response to Arguments

5. The art rejections have been maintained for the following reasons. Notably, the Miyakawa reference has a common assignee with the present invention. Applicants argue that one of ordinary skill in the art would not be motivated to combine Miyakawa and Ishii because the two inventions differ from each other with respect to purpose, technical ideal and effect. Applicants argue that the protective layer in the Ishii invention serves to improve rigidity of the film or prevent deterioration of electric insulation due to damage. However, the protective layer containing optical stabilizer prevents the polyester film from degrading due to UV. The purposes of using the protective layer are not related to each other. The arguments are confusing and not understood. Nothing is wrong for the protective layer to serve many purposes. The difference in the purposes of providing the protective layer has nothing to keep the two applied references from combining to each other. The combination of the two cited references is proper so long as the motivation to combine them is strong and sufficient. In view of the teaching from Isshii, one of skilled in the art would be motivated to incorporate a light stabilizer into the A-layer of Miyakawa motivated to provide the reflective sheet having improved light resistance to ultraviolet light. That is, addition of the light stabilizer into the skin layer of Miyakawa would cause the skin layer less vulnerable to the effect of UV irradiation and thus lowering the

ratio deterioration of the light reflectance, which is important to the expectation of the successfully practicing the invention of Miyakawa. Further, Applicants argue that Ishii discloses deterioration of light reflectance at both wavelengths of 450 mm and 550 mm is less than 10% after the surface of the protective layer is irradiated with an UV light. This indicated the protective layer being deteriorated from degrading due to UV. Therefore, Isshi differs from the present invention at the point that color toner and luminosity may change. Isshi uses a polyolefin sheet that does not turn to yellow upon UV exposure. Applicants then conclude that one of ordinary skill in the art would not motivated to employ the UV absorber in the protective layer of Miyakawa to solve the Applicants' problem of the polyester turning yellow as a consequence of UV exposure. It is reminded that the motivation for the combination of Miyakawa and Ishii may be different than the discovery of the present invention. However, such can not be the basis for patentability when the differences would otherwise be obvious. See ***Ex parte Obiaya***, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

6. The double patenting rejections have been maintained for the following reasons. Applicants argue that the coating of US 5,672,409 contains a fluorescent whitening agent for improving reflectance and a white color tone, which keeps the degree of gloss. Applicants further argue that the coating layer of the present invention and that of the US 5,672,409 as modified by Ishii completely differ from its function. The coating layer of the present invention serves to keep reflective sheet from being deteriorated by UV irradiation and yellowing whereas the

coating of the US 5,672,409 as modified by Ishii to provide the reflective sheet having improved light resistance to ultraviolet light. Again, the motivation to combine the US 5,672,409 and Ishii may be different than the discovery of the present invention. However, such can not be the basis for patentability when the differences would otherwise be obvious. This is in line with ***Ex parte Obiaya***, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

7. Applicants point out that the coating layer containing an optical stabilizer as the main composition ingredient to absorb UV and thus prevent degradation by UV irradiation for the white film. Notably, the optical stabilizer is used as an additive in the Ishii invention. Such recitation should be incorporated in the claims in order to overcome the finding of obviousness.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai Vo
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HV